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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,289	06/13/2000	Paul E. Bender	PA000322	7796

23696 7590 12/03/2003

Qualcomm Incorporated  
Patents Department  
5775 Morehouse Drive  
San Diego, CA 92121-1714

EXAMINER
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NGUYEN, STEVEN H D

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 12/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/593,289

Applicant(s)

BENDER ET AL.

Examiner

Steven HD Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities:

Page 1, lines 33, Please insert – Now USP 6574211 -- after “system”.

Page 5, lines 22-23, page 6, lines 26, page 7, lines 19, page 13, lines 38, please delete “[Attorney Docket No. ACPA990387]” and replace with application number and USP number if available.

Page 1, lines 29, Please insert – Now USP 6539030 -- after “invention”.

Appropriate correction is required.

### ***Claim Objections***

2. Claims 20 and 25 are objected to because of the following informalities:

As claim 20, the acronyms “HDR” must be spell out.

As claim 25, “1” should be changed to – 22 --.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 22-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 22 and 26, the recitation "second radio network" is vague and indefinite because the claim does not recite the first radio network. Please clarify, so the meter and boundary of the claim can be determined.

There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-8, 12 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes (USP 6230009) in view of Silver (USP 6560457).

Regarding claim 1-8, 12 and 14-20, Holmes discloses (Figs 1-4 and col. 1, lines 5 to col. 4, lines 12) a method for receiving messages forwarded from a second radio network (Fig 2, Ref 201) to a first radio network (Fig 2, Ref 252) by establishing a session with the first radio network (Fig 4, Ref 402); sending to the first radio network an first message for indication of an interest in receiving unsolicited messages for a particular set of service options from the second radio network (Fig 4, Ref 403, the mobile notifies the second network must transmit a page message via PCCH of the first network to the mobile) and registering with the second network before receiving a page message (Fig 4, Ref 401) and the unsolicited messages are sent from the second radio network to the first radio network. (Fig 2); the encapsulated message is received from the first radio network on a designated control channel cycle (Fig 2, Ref PCCH). However,

Homes does not disclose the page message must be encapsulating in order to transmit via the PCCH. In the same field of endeavor, Silver discloses (Figs 1-6 and col. 1, lines 17 to col. 9, lines 67) receiving an encapsulated message from the first radio network, wherein the encapsulated message includes an unsolicited message from the second radio network that has been forwarded to the first radio network (Figs 3-4 wherein the mobile receives an encapsulating from the first network via PCCH wherein the encapsulated includes a received unsolicited message "page message" from the second network; See col. 6, lines 1-48) and the first message is sent periodically within a first time interval and the encapsulating and forwarding of the unsolicited messages from the second radio network cease if the first message is not received within a second time interval, wherein the second time interval is longer than the first time interval and sending a second message to the first radio network to request termination of the encapsulating and forwarding of the unsolicited messages from the second radio network. (Col. 7, lines 12-30, the mobile periodically notifies its present to receive the messages and the first network will not forward the message if it does not receive the notified message and it is implicitly discloses if the mobile does not want to receive the message via PCCH, its will send a disconnection message to the first network) and sending a page response message to the second radio network in response to receiving the encapsulated message from the first radio network (Figs 3-4 and Page RESP on DCCH); the encapsulated message received from the first radio network is a paging request message; a voice page; the first radio network is a High Data Rate radio network; the second radio network is a CDMA radio network that conforms to 1S-2000 standard. (Col. 4, lines 40-62 and col. 6, lines 1-31 and Fig 2, HDR is data network 120 and CDMA-2000 is voice network 110).

Since, Homes suggests that MDIS creating a IP packet for transmitting via PCCH to the mobile for alerting an incoming call. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method and system for encapsulating a received page message from the second network at the first network for transmitting to the mobile station as disclosed by Silver into Holmes' system and method. The motivation would have been to reduce a delay for setting up a telephone call.

7. Claims 9-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes and Silver as applied to claims 1 above, and further in view of Stephens (USP 6600920).

Regarding claims 9 and 11, Holmes and Silver do not fully disclose the claimed invention. However, Stephens discloses establishing a connection with the second radio network in response to receiving the encapsulated message and the unsolicited messages are sent from a mobile station controller to the first and second radio networks (Figs 7-8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to establish a communication channel between the second network and mobile as disclosed by Stephens' system into the system of Holmes and Silver. The motivation would have been to reduce a delay for setting up a telephone call.

Regarding claims 10 and 13, Holmes does not fully disclose the claimed invention. Silver discloses an encapsulating message. However, it is well known and expected in the art for an encapsulated message includes an Access Terminal Identifier (ATI) Record field indicative of an address of a recipient access terminal, a Message ID field that indicates that the message is an encapsulated message, and a message field indicative of one or more paging records for the recipient access terminal for forwarding via forward channel. Therefore, it would have been

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obvious to one of ordinary skill in the art at the time of the invention was made to apply these field into an encapsulated message of Silver for forwarding via traffic channel instead of packet control channel is a designer choice. The motivation would have been to reduce a delay for setting up a telephone call.

8. Claims 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes (USP 6230009) in view of Silver (USP 6560457) and Chevillat (USP 6181683).

Holmes and Silver discloses the claimed invention as set forth of the claims 1, 4-7 and 20 of paragraph 6 of the office action. However, Holmes and Silver does not fully disclose a transceiver for modulating the coded data and converting the modulated data into modulated signal suitable for transmitting via medium and demodulating the received signal and decoding the demodulated data to recover the transmitted data and controller. In the same field of endeavor, Chevillat disclose (Fig 2 and 5) disclose a transceiver for modulating the coded data and converting the modulated data into modulated signal suitable for transmitting via medium and demodulating the received signal and decoding the demodulated data to recover the transmitted data and controller.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method for modulating the coded data and converting the modulated data into modulated signal suitable for transmitting via medium and demodulating the received signal and decoding the demodulated data to recover the transmitted data and controller as disclosed by Chevillat's system into the system of Holmes and Silver. The motivation would have been to reduce a delay for setting up a telephone call.

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*Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dahlin (USP 6122263) discloses a Internet access for a cellular networks.

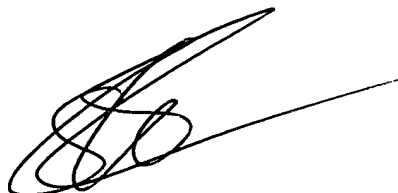
Lupien (USP 6463055) discloses a method for paging the mobile via PCCH of the first network and establishing a communication via second network.

Lupien (USP 6389008) a method for paging the mobile via PCCH of the first network and establishing a communication via second network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D Vu can be reached on (703) 308-6602. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



Steven HD Nguyen  
Primary Examiner  
Art Unit 2665  
11/17/03